

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-20, 96, and 97 are pending in the application, with claims 1, 96, and 97 being the independent claims. Claims 21-95 were previously cancelled. Claims 1, 3, 7, 10, 14, 16, 96, and 97 are currently amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Accordingly, based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objections to the Drawings

On page 2 of the Office Action, the Examiner objected to the drawings because

- (1) reference character "102" allegedly has been used to designate both a step for an action needed and an arrow for coupon UPC; and
- (2) the drawings allegedly include the following reference character(s) not mentioned in the description: 45, 72, 83, 138, 202, and 100.

The specification has been amended to address the Examiner's concerns. More specifically, paragraph [0079] has been amended to remedy the confusion regarding reference character 102. Furthermore, paragraphs [0046], [0058], [0073], [0074], [0079], and [0090] have been amended to mention respective reference characters 45, 72, 83, 138, 202, and 100. Support for these changes may be found, for example, in respective figures 2D, 5, 6B, 6C, 6E, and 9.

Marked up and clean versions of the substitute specification are submitted herewith in accordance with 37 C.F.R. § 1.125(c). These amendments add no new matter.

Applicants therefore respectfully request that the objections to the drawings be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 112

Claims 14, 16, and 17

On page 2 of the Office Action, claims 14, 16, and 17 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Based on the following remarks and amendments, Applicants respectfully traverse this rejection.

The Examiner contends that there is insufficient antecedent basis for "the first retail store" in claims 14, 16, and 17. Claims 14 and 16 have been amended accordingly. More specifically, claims 14 and 16 have been amended to recite "...at a first retailer of the plurality of retailers" Furthermore, Applicants assert that the amendment of claim 16, from which claim 17 depends, renders the rejection under 35 U.S.C. § 112 of claim 17 moot. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 112 of claims 14, 16, and 17 be reconsidered and withdrawn, and that these claims be passed to allowance.

Claims 8-10

On page 3 of the Office Action, claims 8-10 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

The Examiner alleges that claim 8 is incomplete for omitting at least one essential step, such alleged omission amounting to a gap between the steps. The Examiner relies generally on pages 9 and 21 of the present application to show the alleged omitted step of correlating customer product purchase information with the customer to create a proposed shopping list based on the customer's past or current purchase history. However, the cited material merely indicates one exemplary embodiment. It should be noted that claims 8-10 are not limited to this embodiment.

Applicants assert that the alleged omitted step is not an essential step of claims 8-10. For instance, Applicants' specification describes embodiments in which correlating customer product purchase information with the particular customer in order to create a proposed shopping list based on the customer's past or current purchase history is not necessary. For example, paragraph 40 of Applicants' specification recites that "a manufacturer ... may offer ... incentives to a customer ... *regardless of the purchases of the customer*" (emphasis added). Furthermore, paragraph 44 of Applicants' specification recites that incentives may be generated "based upon a customer's past purchasing history, a customer's present purchases, a combination of these two, *or other suitable techniques*" (emphasis added). Moreover, paragraph 48 of Applicants' specification recites that "[a]s an alternative, kiosk 47 may communicate incentives available to all

customers, as opposed to particularly identified customers, in which case communication of individual electronic discounts to incentive controller 44 is unnecessary." Further still, paragraph 64 of Applicants' specification recites that a "manufacturer may communicate incentives to customers ... independent of the purchases of a particular customer in a current transaction." Additionally, paragraph 68 of Applicants' specification recites that "[t]his type of price matching or beating could be implemented for all customers or for only particular customers."

For at least the reasons set forth above, Applicants assert that correlating customer product purchase information with the particular customer in order to create a proposed shopping list based on the customer's past or current purchase history is not an essential step of claims 8-10. Thus, Applicants assert that claims 8-10 are not incomplete for omitting at least one essential step.

Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 112 of claims 8-10 be reconsidered and withdrawn, and that these claims be passed to allowance.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 4, 11, 16, 17, 96, and 97

On page 4 of the Office Action, claims 1, 2, 4, 11, 16, 17, 96, and 97 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,873,069 to Reuhl *et al.* (hereinafter "Reuhl"). Applicants respectfully traverse this rejection.

Amended independent claim 1 recites, among other features, *detecting, at a remote computer, product purchase information of a plurality of different retailers from points-of-sale associated with the respective retailers.*

The Examiner relies on Col. 3, lines 18-28, Col. 8, lines 64-68, and Col. 10, lines 15-32 of Reuhl to allegedly show this feature. However, upon inspection, nothing in the cited material or any other portion of Reuhl teaches *detecting product purchase information at a plurality of different retailers from points-of-sale associated with the respective retailers.* Instead, the system in Reuhl requires a user to input product and price data of a competitor, including the competitor's advertised price or the shopped price of the competitor. *See, e.g.,* Reuhl, Col. 4, lines 14-16; Col. 9, lines 1-4; Col 15, lines 11-24 and 34-44; and Col. 16, lines 5-27. The advertised price is defined in Reuhl as the price for an item described or shown in an advertisement, written or otherwise. Reuhl, Col. 6, lines 57-61. The shopped price is defined in Reuhl as the price on the competitor's price tag on an item. Reuhl, Col. 6, lines 54-57. The user inputs the product and price data using a plurality of entry screens, as described, for example, at Col. 15, lines 11-24 and 34-44, and Col. 16, lines 5-27 of Reuhl. Inputting an advertised price or a shopped price of a competitor by a user using a plurality of entry screens is not the same as detecting product purchase information at a plurality of different retailers from points-of-sale associated with the respective retailers, as recited in Applicants' claim 1, as amended.

For at least the reasons set forth above, Applicants assert that independent claim 1, as amended, is patentable over Reuhl.

Furthermore, claims 2, 4, 11, 16, and 17, all of which depend from independent claim 1, are also patentable over Reuhl for reasons similar to those set forth above with respect to independent claim 1, as amended, and further in view of their own respective features.

Moreover, amended independent claims 96 and 97 are patentable over Reuhl for reasons similar to those set forth above with respect to independent claim 1, as amended, and further in view of their own respective features.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, 4, 11, 16, 17, 96, and 97.

Rejections under 35 U.S.C. § 103

Claims 3, 5 and 7

On page 7 of the Office Action, claims 3, 5, and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reuhl in view of U.S. Patent No. 6,070,147 to Harms *et al.* (hereinafter "Harms"). Applicants respectfully traverse this rejection.

The Examiner does not provide an argument regarding the rejection of claim 7. Nevertheless, the discussion below addresses claim 7 along with claims 3 and 5. Claims 3, 5, and 7, all of which directly depend from independent claim 1, are also patentable over Reuhl for reasons similar to those set forth above with respect to Applicants' claim 1, as amended, and further in view of their own respective features. Moreover, Applicants assert that Harms does not provide the teachings missing from Reuhl.

Accordingly, Applicants assert that claims 3, 5, and 7 are patentable over Reuhl and Harms, alone or in any rational combination.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 5, and 7.

Claim 6

On page 8 of the Office Action, claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reuhl in view of Harms and further in view of U.S. Pat. No. 6,076,070 to Stack (hereinafter "Stack"). Applicants respectfully traverse this rejection.

Claim 6, which indirectly depends from independent claim 1, is also patentable over Reuhl for reasons similar to those set forth above with respect to Applicants' claim 1, as amended, and further in view of its own features. Moreover, Applicants assert that Harms and Stack do not provide the teachings missing from Reuhl. Accordingly, Applicants assert that claim 6 is patentable over Reuhl, Harms, and Stack, alone or in any rational combination.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 6.

Claims 7-10

On page 9 of the Office Action, claims 7-10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reuhl in view of U.S. Pub. No. 2001/0014868 to Herz *et al.* (hereinafter "Herz"). Applicants respectfully traverse this rejection.

Claims 7-10, all of which depend from independent claim 1, are also patentable over Reuhl for reasons similar to those set forth above with respect to Applicants' claim 1, as amended, and further in view of their own respective features. Moreover, Applicants assert that Herz does not provide the teachings missing from Reuhl. Accordingly, Applicants assert that claims 7-10 are patentable over Reuhl and Herz, alone or in any rational combination.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 7-10.

Claims 12-15 and 18-20

On page 11 of the Office Action, claims 12-15 and 18-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reuhl in view of the Examiner's Official Notice. Applicants respectfully traverse this rejection.

Claims 12-15 and 18-20, all of which depend from independent claim 1, are also patentable over Reuhl for reasons similar to those set forth above with respect to Applicants' claim 1, as amended, and further in view of their own respective features. Moreover, Applicants assert that the Examiner's Official Notice does not provide the teachings missing from Reuhl. Accordingly, Applicants assert that claims 12-15 and 18-20 are patentable over the combination of Reuhl and the Examiner's Official Notice, alone or in combination.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 12-15 and 18-20.